

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 22, 2005. To clarify various aspects of inventive subject matter Applicants amend Claims 26 and 45. Applicants also introduce new Claims 46-47 and cancel Claims 15 and 44 without prejudice or disclaimer. To advance prosecution of this application, Applicants have responded to each notation by the Examiner. Applicants submit that all of the pending claims are in allowable over the cited references. Applicants respectfully request reconsideration, further examination, and favorable action in this case.

Subject Matter Indicated as Allowable

Applicants note with appreciation the Examiner's statement that Claims 1-2, 4-13, 25, 27-28, 30-33, 39, and 41-42 are allowed.

Objection to Drawings

The Examiner objects to the drawings under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Applicants have amended Claim 45 and cancelled Claim 44 to address the informalities identified by the Examiner. Applicants further submit that at least FIGURE 16d and the written description illustrate every feature in Claims 26 and 45-47. For example, at least FIGURE 16d shows a wavelength division demultiplexer (shown at least by the unlabeled wavelength division demultiplexer that receives signal 1660), a first beam splitter (shown at least by element 1620a), MEMS device (shown at least by element 1630 or 1640), a second beam splitter (shown at least by element 1650b), and a wavelength division multiplexer (shown at least by the unlabeled wavelength division multiplexer that receives signals 1676). Moreover, the specification discloses that a beam splitter can divide an optical signal into at least a first part and a second part where the first part comprises an amplitude that is different than an amplitude of the second part. *See e.g., Page 16, Line 26 through Page 17, Line 7.* For at least these reasons, Applicants respectfully requests withdrawal of the drawing objection and full allowance of amended Claim 26, and all claims depending therefrom.

Claim Rejection 35 U.S.C. § 112

The Examiner rejects Claims 44-45 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants have amended Claims 26 and 45, and have cancelled Claim 44 in order to address the informalities identified by the Examiner. Applicants further submit that amended Claims 26 and 45, and new Claims 46-47 recite an apparatus for wavelength division add/drop multiplexing. Applicants' disclosure is sufficient to convey to one skilled in the art that, as of the filing date, applicants were in possession of the invention as claimed. In the Application, at least FIGURE 16d illustrates an exemplary embodiment of a wavelength division add/drop multiplexing. In particular, at least FIGURE 16d shows a wavelength division demultiplexer (shown at least by the unlabeled wavelength division demultiplexer that receives signal 1660), a first beam splitter (shown at least by element 1620a), MEMS device (shown at least by element 1630 or 1640), a second beam splitter (shown at least by element 1650b), and a wavelength division multiplexer (shown at least by the unlabeled wavelength division multiplexer that receives signals 1676). Moreover, the specification discloses that a beam splitter can divide an optical signal into at least a first part and a second part where the first part comprises an amplitude that is different than an amplitude of the second part. *See e.g., Page 16, Line 26 through Page 17, Line 7.* For at least these reasons, Applicants respectfully requests withdrawal of the drawing objection and full allowance of amended Claim 26, and all claims depending therefrom.

Moreover, the Examiner has not explained why Applicants' written description fails to convey to those skilled in the art that, as of the filing date, Applicants were in possession of the invention as claimed. The Examiner has not met his initial burden "of presenting evidence by a pre-ponderance of evidence why a person skilled in the art would not recognize" in the present application, a description of the invention as defined by the claims. Nevertheless, for the Examiner's convenience, Applicants have identified example locations in the originally filed specification that support the claimed subject matter. Consequently, Applicant respectfully requests withdrawal of the rejection of Claim 45.

Claim Rejection 35 U.S.C. § 103

The Examiner rejects Claims 26 and 43 under 35 U.S.C. § 103(a) as being unpatentable over *Kiang* and further in view of U.S. Patent 5,945,898 by Judy et al. ("*Judy*"). The Examiner also rejects Claims 26 and 43 under 35 U.S.C. § 103(a) as being unpatentable over *Kiang* and further in view of U.S. Patent 6,897,539 B2 by Behin et al. ("*Behin*"). Claims 26 and 43 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 6,928,244 B1 by Goldstein et al. ("*Goldstein*") and further in view of *Judy*. The Examiner finally rejects Claims 26 and 43 under 35 U.S.C. § 103(a) as being unpatentable over *Goldstein* and further in view of *Behin*. Applicants respectfully traverse these claim rejections for the reasons discussed below.

To defeat a patent under 35 U.S.C. § 103, "the prior art reference must teach, disclose, or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. § 706.02(j). Applicants respectfully submit that none of the cited references, taken alone or in combination, teach or suggest, either expressly or inherently, a number of elements of Claim 26.

Applicants submit that amended Claim 26 is patentable over *Kiang* in view of *Judy* or *Behin*. Applicants further submit that amended Claim 26 is patentable over *Goldstein* in view of *Judy* or *Behin*. Among other features, amended Claim 26 recites, in part, that "at least one of the add/drop multiplexers comprising a beam splitter operable to receive at least a portion of the optical input signal and split the at least a portion of the optical input signal into a first copy and a second copy, wherein the first copy and the second copy of the optical input signal comprise unequal amplitudes, and a micro-electro-optic system (MEMS) device."

Applicants submit that amended Claim 26 is patentable over *Kiang* in view of *Judy* or *Behin*. For example, nowhere does *Kiang* contemplate an add/drop multiplexer that comprises a beam splitter operable to receive at least a portion of the optical input signal and split the at least a portion of the optical input signal into a first copy and a second copy, wherein the first copy and the second copy of the optical input signal comprise unequal amplitudes, and a micro-electro-optic system (MEMS) device. Consequently, *Kiang* fails to teach or suggest amended Claim 26.

The teachings of *Judy* and *Behin* do not make up for the deficiencies of *Kiang*. At the outset, Applicants note that nowhere does *Judy* or *Behin* disclose or suggest implementing a beam splitter within their respective devices. For at least these reasons, Applicants submit that *Kiang* and *Judy* or *Behin*, taken alone or in combination, fail to teach or suggest amended Claim 26. Applicants respectfully request withdrawal of the rejection and full allowance of amended independent Claim 26 and all claims depending therefrom.

Applicants submit that amended Claim 26 is patentable over *Goldstein* in view of *Judy* or *Behin*. For example, nowhere does *Goldstein* contemplate an add/drop multiplexer that comprises a beam splitter operable to receive at least a portion of the optical input signal and split the at least a portion of the optical input signal into a first copy and a second copy, wherein the first copy and the second copy of the optical input signal comprise unequal amplitudes, and a micro-electro-optic system (MEMS) device. Consequently, *Goldstein* fails to teach or suggest amended Claim 26. Moreover, as discussed above, nowhere does *Judy* or *Behin* disclose or suggest implementing a beam splitter within their respective devices. For at least these reasons, Applicants submit that *Goldstein* and *Judy* or *Behin*, taken alone or in combination, fail to teach or suggest amended Claim 26. Applicants respectfully request withdrawal of the rejection and full allowance of amended independent Claim 26 and all claims depending therefrom.

No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the *Kiang*, *Behin*, *Goldstein*, and *Judy* references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicants are sufficient to overcome the anticipation and obviousness rejections.

Attorney's Docket:
074036.0108



Patent No.:
09/746,822

22

CONCLUSION

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicants respectfully request reconsideration and full allowance of all pending Claims.

Applicants believe that no fees are due. However, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

If the Examiner feels that a conference would advance prosecution of this Application in any manner, Brian J. Gaffney stands willing to conduct such a telephone interview at the convenience of the Examiner. Mr. Gaffney may be reached at (214) 953-6682.

Respectfully submitted,
BAKER-BOTTS L.L.P.
Attorneys for Applicants

Brian J. Gaffney
Reg. No. 51,712

Correspondence Address:

Customer No.

05073

Date: Nov. 21, 2005